

REMARKS

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of November 24, 2008 is respectfully requested.

In the outstanding Office Action, the Examiner rejected all of pending claims 13-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserted that the phrase “average *total* area” recited in claims 13-26 submitted with the previous amendment filed September 15, 2008 introduced new matter. The language cited by the Examiner as introducing new matter was added in the previously-submitted claims in an effort to address the Examiner’s previous indefiniteness rejections of the original claims. Although the Applicants do not acquiesce to the Examiner’s new matter rejections under § 112, it is noted that the claims have now been amended in an effort to address all of the Examiner’s concerns, including indefiniteness and new matter. For the reasons discussed below, it is respectfully submitted that the Examiner’s formal rejections under § 112 have been overcome.

As noted above, the previously-submitted claims were drafted in an effort to address the Examiner’s concern that the phrase “an average area” appearing in original claim 1 was unclear and therefore indefinite. The Examiner’s indefiniteness concerns were not entirely understood because it is the Applicants’ position that one of ordinary skill in the art would clearly recognize and understand the meaning of the phrase “an average area” as used in the original claims based on the entire original disclosure of the present application. Nonetheless, an effort was made to address the Examiner’s concerns by clarifying the original claim language to overcome the Examiner’s indefinite rejection. Unfortunately, the Applicants’ effort to overcome the earlier indefiniteness rejections of the claims has now caused the Examiner to reject the claims as failing to comply with the written description requirement.

Thus, the Applicants have now attempted to further amend the claims in order to (1) clarify the original claim language in an effort to address the Examiner’s earlier indefiniteness rejection; and (2) also address the Examiner’s recent written description rejections. In particular, the term “total” has now been deleted from the claims, and the claims have been further amended

to clarify that the phrase “an average area” refers to the area that is *covered by* each molten particle of the metal thermal spray material when the molten particles have stuck to the surface. In this regard, as explained throughout the original disclosure, the object of the present invention is to provide a process for *coating* a metal body so as to prevent corrosion. To this end, page 11, lines 5-19 of the original specification explains that molten particles collide against a thermal spray subject (i.e., the metal body), and are deposited on the surface. Thus, the object of coating the metal body is achieved by having the molten particles collide against the metal body so as to be deposited on the metal body. Of course, when considering depositing particles on a metal body in order to coat the metal body, it is natural to consider how much area will be covered (or coated) by each particle. As such, it follows from the purpose of “coating” an object that the “average area” of each molten particle that has stuck to the surface of the metal body would refer to the average area “covered by” the stuck molten particle. Consequently, based on the purpose and the entire disclosure of the present invention as set forth in the original drawings and specification, it is submitted that one of ordinary skill in the art would clearly understand that the “average area” recited in the claims refers to the average area “*covered by* each molten particle of the metal thermal spray material when the molten particles have stuck to the surface of the metal body.” It is therefore submitted that the amendments clarifying the phrase “average area” as discussed above do not introduce any new matter, and therefore overcome the Examiner’s formal rejections under 35 U.S.C. § 112, first paragraph. Moreover, it is submitted that, to the extent that the original claim language was indefinite, the amendments described above also clearly overcome those issues.

The Examiner also rejected claims 13 and 22-25 as being unpatentable over the TS reference (Thermal Spraying: Practice, Theory, and Application) in view of the Browning reference (U.S.P. 4,762,977), the Kang reference (U.S.P. 4,788,077), and either the Marcos reference (U.S.P. 3,052,590), or the Tenkula reference (U.S.P. 5,123,152); and rejected claim 26 as being unpatentable over the TS reference in view of the Browning reference, the Kang reference, and either the Marcos reference or the Tenkula reference, and further in view of the Cole reference (U.S.P. 5,407,035). However, in responding to the Applicants’ previous remarks

submitted September 15, 2008 concerning the Examiner's earlier prior art rejections, the Examiner discussed the Applicants' arguments regarding the benefits of using the specific recited range of the particle area. In particular, the Examiner accepted the arguments regarding the specific range as recited in the claims with respect to *plasma* spraying as recited in original claim 14, because the evidence and facts relied on by the Applicant were specific to such plasma spraying. As such, the Examiner applied no prior art rejections for claims 14-21, as all of those claims related to *plasma* spraying.

In view of the Examiner's remarks, independent claim 13 has also now been amended to incorporate the features of dependent claim 14. Therefore, independent claim 13 is now directed to a *plasma* spraying method, in which the recited ranges having the benefits discussed in the remarks filed September 15, 2008 and in the specification. Therefore, in view of the Applicants' previous comments, as well as the Examiner's remarks on page 9 of the outstanding Office Action and the lack of any prior art rejections, it is respectfully submitted that amended independent claim 13 and the claims that depend therefrom are clearly patentable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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